

in ethyl alcohol and water in an amount sufficient to effect *in vivo* destruction of carcinoma cells.

REMARKS

Reconsideration of this application is requested.

Claims 1-8, 17-19, and 25-27 are allowed in view of the Declaration (Paper No. 12) dated October 30, 2001 by Dr. Jones.

The rejection of claims 9-16 as "unpatentable over the Arcadi references (1986) and (1990) of record" is not understood. These claims define the solution which the inventor found to be effective in treating human prostate cancer. The October 30, 2001 Declaration by Dr. Jones makes it clear that "Dr. Arcadi's 1986 and 1990 articles would not cause one of ordinary skill in this work to reasonably expect that Rhodamine-123 would be any more effective in combating human prostate carcinoma than any of many other drugs which have been tested *in vitro* and in laboratory animals with promising results, but which have failed to produce any therapeutic effects in human patients." (See paragraph no. 7 of the Declaration.) Nothing in either of Dr. Arcadi's articles discloses or suggests a solution of Rhodamine-123 in an alcohol and water, which can be used to prolong the life of victims of prostate carcinoma.

Applicant does not understand the statement in the Office action that "Clearly, a showing of the prior pharmaceutical composition is needed." Nothing in either of the Arcadi articles discloses or even suggests the Rhodamine-123 solution defined in claims 9-16 for effective treatment of human prostate carcinoma. If this rejection is repeated, please cite authority for it.

The rejection of claims 20 and 22-24 as "unpatentable over the Bernal et al. reference" is not understood. The animal experiments referred to in the Bernal et al. reference are no more relevant than those described in the Arcadi references, and were disposed of by the Jones Declaration referred to above.

Claims 20-24 were rejected "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time of the application was filed, had possession of the claimed invention. No basis is seen in the specification and claims as filed to the terms [sic] 'carcinoma'." The accompanying Declaration ("second Declaration") dated July 22, 2002 by Dr. Lawrence W. Jones (attached as Exhibit "A") makes it clear that the subject matter objected to in the Office action is not "new matter". The application as originally filed disclosed how to treat prostate cancer successfully. Prostate cancer is one of many forms of carcinoma, which is any cancer of epithelial origin. That includes cancer of the breast, liver, pancreas, bladder, lung, skin, colon, and the like. Moreover, the application states on page 1 at line 24 that "Rh-123 is selectively toxic for carcinoma cells".

The second Declaration of Dr. Jones also makes it clear that the application describes how to administer Rhodamine-123 safely to patients so the efficacy of the drug for treating all types of carcinoma can be determined by routine experiments, i.e., without undue experimentation.

In view of the explanation set forth in the attached Declaration of Dr. Jones, the objection to the Amendment filed January 8, 2002 as introducing new matter should be withdrawn.

New claim 28 added by this Amendment is similar to allowed claim 1, except that claim 28 is not limited to treatment of prostate cancer. Applicant is entitled to the more generic claim because it has long been the law that "A specification may, within the meaning of 35 U.S.C. § 112, ¶ 1, contain a written description of a broadly claimed invention without describing all species that claim encompasses." *Utter v. Hiraga*, 845 F.2d 993 (Fed. Cir. 1988). Claim 28 should not be rejected because of "overbreadth". "[T]hat word . . . has long ago been discredited as a basis for determining

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sufficiency of a specification". See *In re Marzocchi*, 439 F.2d 220, 223, 169 U.S.P.Q. 367, 369, 58 C.C.P.A. 1069 (1971), which held that the Patent Office should be concerned with support or non-support of a generic term, not its breadth. In the present case, the treatment of carcinoma is clearly supported by the disclosure and the application.

This application is in condition for allowance, and such action at an early date is requested.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By R. W. Johnston
R. William Johnston
Reg. No. 17,968
626/795-9900

RWJ/mas

Enclosure: Exhibit A

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